



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,736	01/26/2001	Richard William Falla Le Page	031855.0093	7582

21967 7590 05/06/2003

HUNTON & WILLIAMS  
INTELLECTUAL PROPERTY DEPARTMENT  
1900 K STREET, N.W.  
SUITE 1200  
WASHINGTON, DC 20006-1109

EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT PAPER NUMBER

1637

DATE MAILED: 05/06/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

09/769,736

Applicant(s)

LE PAGE ET AL.

Examiner

Suryaprabha Chundurur

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Election/Restrictions**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3, 10-11 and 17, drawn to a group B Streptococcus protein, or polypeptide, peptide fragments, and a kit, requiring SEQ ID Nos. from Figs. 1 and 2, classified in class 530, subclass 350 and classified in class 514, subclass 2.
  - II. Claims 4-8, 10-11 and 18, drawn to a nucleic acid molecule, host cell, vector, and a kit, requiring SEQ ID Nos. from Figs. 1 and 2, classified in class 536, subclass 23.1.
  - III. Claims 9, 16, drawn to an antibody, and a kit, requiring SEQ ID Nos. from Figs. 1 and 2, classified in class 424, subclass 130.1.
  - IV. Claim(s) 12, drawn to a use of immunogenic composition, requiring SEQ ID Nos. from Figs. 1 and 2, classified in class 424, subclass 9.2.
  - V. Claim(s) 13, drawn to a method of detection of Group B Streptococcus comprising antibody, requiring SEQ ID Nos. from Figs. 1 and 2, classified in class 435, subclass 7.2.
  - VI. Claim(s) 14, drawn to a method of detection of Group B Streptococcus comprising at least one protein, polypeptide, peptide, fragments or derivatives thereof, requiring SEQ ID Nos. from Figs. 1 and 2, classified in class 435, subclass 71.1.
  - VII. Claim(s) 15, drawn to a method of detection of Group B Streptococcus comprising at least one nucleic acid molecule, requiring SEQ ID Nos. from Figs. 1 and 2, classified in class 435, subclass 6.

VIII. Claims 19-21, drawn to a method of screening for DNA encoding bacterial cell envelope comprising transformation, requiring one of the pTREP1-nuc vectors shown in Fig. 4, requiring SEQ ID Nos. from Fig. 4, classified in class 514, subclass 44.

IX. Claim(s) 22, drawn to one of pTREP1-nuc vectors shown in Fig. 4, requiring SEQ ID Nos. from Fig. 4, classified in class 435, subclass 320.1.

X. Claim(s) 23, drawn to a method of determining whether a protein, polypeptide, peptide, fragment or derivative thereof is a potential anti-microbial target, requiring SEQ ID Nos. from Figs. 1 and 2, classified in class 424, subclass 184.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions in Group I and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product in Group I can be used in a materially different processes such as protein truncation assay or enzymatic assays.

Inventions in Group I and X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product in Group I can be used in a materially different processes such as protein truncation assay or enzymatic assays.

Inventions in Group II and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product in Group II can be used in a materially different processes such as gene therapy or amplification assays.

Inventions in Group III and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product in Group III can be used in a materially different processes such as protein purification assay or protein complement assays.

Inventions in Group IX and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product in Group IX can be used in a materially different processes such as gene therapy or hybridization assays.

Inventions VII and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the inventions in Group VII and VIII have different modes of operation, different functions and

Art Unit: 1637

different results. For instance, the inventions in Group VII and VIII can be used independently from each other because each method of Groups VII and VIII has different mode of operation with different function and effect.

Inventions VI and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the inventions in Group VI and X have different modes of operation, different functions and different results. For instance, the invention in Group VI is used to the detection of Group B Streptococcus with an end result of detecting the microorganism. It has different mode of operation with different function and effect.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and the search for one group is not required for any other group, restriction for examination purposes as indicated is proper.

In this application additionally, applicant is required to specify *one* specific sequence for examination. This requirement is made under 1192 O.G. 68 Notice (November 19, 1996 and revised MPEP), as the examination of more than one sequence in the application would result in an undue search burden on the PTO.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1637

Applicant is reminded that upon the cancellation of claims to non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 703-305-1004. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Bezion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Suryaprabha Chunduru

April 16, 2003

  
JEFFREY FREDMAN  
PRIMARY EXAMINER